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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **R. Michael McGrady, et al.**)

Serial No.: **09/014,076**)

Filed: **January 27, 1998**)

Title: **Method For Tracking And
Dispensing Medical Items**)

Art Unit 3651

Patent Examiner:
Michael E. Butler

TO 3600 MAIL ROOM

Director of Technology Center 3600
Commissioner for Patents
Washington, D.C. 20231

Sir:

Appellants received a Notification of defective appeal brief, including a holding of noncompliance with 37 C.F.R. § 1.192(c), dated May 4, 2001. If a request for reconsideration is first required, then this petition should be considered as such.

Petition For Withdrawal of Holding of Defective Appeal Brief

Appellants respectfully petition against the holding of defective appeal brief, including a holding of a noncompliance with 37 C.F.R. § 1.192(c), dated May 4, 2001. Appellants respectfully petition for the withdrawal of the holding of defective appeal brief. Appellants' Brief

was asserted by the Examiner to be defective because it exceeded a brief size limit. That is, the Brief was held to exceed an alleged 30-page, 14,000 words, or 1,300 lines limitation. The Appellants maintain that this is not a legal basis for holding the Brief defective and in noncompliance with 37 C.F.R. § 1.192(c).

The Notification of defective appeal brief dated May 4, 2001 ("Notification") asserts that the PTO is an administrative agency, and because of the Administrative Procedures Act unless a statute on point or an agency promulgated rule on point exists, then the Federal Rules of Evidence and Federal Rules of Appellate Procedure apply.

That erroneous assertion was purportedly based on 5 U.S.C. § 559, which is part of the Administrative Procedures Act. However, that statute does not state that the Federal Rules of Evidence and Appellate Procedure apply to Federal agencies if there is not a specific agency rule on the matter. A copy of 5 U.S.C. § 559 is attached hereto. The specific part of the Statute misquoted by the Examiner, states "Except as otherwise required by law, requirements or privileges relating to evidence or procedure apply equally to agencies and persons."

The Statute provides that Due Process applies equally to agencies and people. It does not imply that the Federal Rules of Appellate Procedure, let alone the brief page limit in such Rules, applies to appeals to the Board of Patent Appeals and Interferences.

The few cases that have mentioned the cited Statute (or its predecessor, 5 U.S.C.A. § 1011) have considered issues related to Due Process, such as whether certain documents had to be made available before an administrative hearing was held, what steps needed to be followed before a new Indian reservation was created and what standard should be used to evaluate the agency's decisions. Sperry and Hutchinson Co. v. F.T.C., 256 F. Supp. 136, 143; U.S. v. Libby,

McNeil & Libby, 107 F. Supp. 697, 703. Similarly, in Dickinson v. Zurko, No. 98-377, 527 U.S. 150 (1999) the courts were concerned with issues of Due Process, not the Federal Rules of Evidence or the Federal Rules of Appellate Procedure.

Zurko is an appeal of a U.S. Patent Office decision. Id. However the decision in Zurko does not in any way hold or imply that the Federal Rules of Appellate Procedure are applicable to appeals before the Board of Patent Appeals and Interferences. The United States Supreme Court only decided the standard of review for a patent appeal in the Federal Circuit Court of Appeals. Id. The Examiner incorrectly cited the case in attempting to make an argument for which there is absolutely no legal support.

Rule 1 of the Federal Rules of Appellate Procedure states, "These rules govern procedure in the United States courts of appeals." It does not say that the Federal Rules of Appellate Procedure apply to the agencies of the U.S. Government.

Contrary to the Examiner's assertion the courts have stated that absent an express agency rule the Federal Rules of Evidence do not apply to administrative proceedings. U.S. Steel Mining Co., Inc. v. Director, Office of Workers' Compensation Programs, 187 F. 3d 384, 388 (4th Cir. 1999) and Peabody Coal Co. v. Director, Office of Workers' Compensation Programs, 165 F. 3d 1126, 1128-1129 (7th Cir. 1999). Similarly the Federal Rules of Appellate Procedure also do not apply to administrative agencies, absent an express agency rule making such rules applicable. The U.S. Patent Office has no such rule.

The invalid conclusion of the Examiner is that unless there is a statute or agency promulgated rule on point, then the Federal Rules of Evidence and the Federal Rules of Appellate Procedure are applicable to administrative agencies. Appellants have shown that

conclusion to be unsupported and courts have reached the exact opposite conclusion. However even if the Examiner's position were correct, there are rules promulgated by the Patent and Trademark Office that apply specifically to appeals before the Board of Appeals and Interferences. Because specific agency rules have been promulgated which have different provisions, the Federal Rules of Appellate Procedure do not apply to Appellants' Brief.

The Notification admits that "There is no statutory limit within Titles 35 or 5 of the Code or Title 37 of the Rules on brief size before the Board." The Appellants agree with the Examiner that there is no limit within the statutes, rules, or Office procedures concerning the length of a brief presented to the Board. Furthermore, it is respectfully submitted that an agency (PTO) promulgated rule directly on point already exists. MPEP § 1206 at page 1200-9 (Rev. 1. Feb. 2000) clearly states:

37 CFR 1.192(c) merely specifies the minimum requirements for a brief, and does not prohibit the inclusion of any other material which an appellant may consider necessary or desirable, for example, a list of references, table of contents, table of cases, etc. A brief is in compliance with 37 CFR 1.192(c) as long as it includes items (1) to (9) in the order set forth (with the appendix, item (9), at the end).

Appellants' Brief includes items (1) to (9). Thus, Appellants' Brief is in compliance with 37 C.F.R. § 1.192(c) and is not defective.

Further evidence that Appellants' Brief is in compliance with the PTO Rules may be obtained from the Notification itself. Nowhere in the Notification is it indicated that Appellants'

Brief does not contain the items (1) to (9). Thus, the Office itself by inference admits that Appellants' Brief contains items (1) to (9) and is in compliance with 37 C.F.R. § 1.192(c).

Furthermore, 37 C.F.R. § 1.192 requires that Appellants "must set forth the authorities and arguments on which appellant will rely to maintain the appeal" and "the brief shall contain the following items" (1) to (9). Attention is also directed to 37 C.F.R. § 1.111 and 37 C.F.R. § 1.113. It is noted that 37 C.F.R. § 1.111 requires a "reply to every ground of objection and rejection." To set a limit on the size of a brief would be in direct conflict with the requirements imposed on Appellants by the statutes and rules, including 37 C.F.R. § 1.192(c)(8) which requires Appellants to explain the errors in each rejection presented. In cases like the present appeal, thirty (30) pages are not sufficient to comply with the express requirements of 37 C.F.R. § 1.192 for all the pending claims and grounds for rejection.

Furthermore, an Appellants' representative spoke with Mr. Craig Feinberg (Administrator for Patent Appeals and Interferences) from the Board on April 17, 2001 concerning any rule on brief sizes. Mr. Feinberg assured Appellants' representative that he was unaware of any limitation on the size of a brief. The Board of Appeals and Interferences has received numerous briefs from Appellants' representative and others that exceed thirty (30) pages without objection.

Furthermore, it is respectfully submitted that the Notification is not in compliance with the procedural rules of the Office. MPEP § 1206 at page 1200-10 (Rev. 1, Feb. 2000) states that "The examiner may use the form paragraphs set forth below or form PTOL-462, 'Notification of Non-Compliance with 37 CFR 1.192(c),' to notify appellant that the appeal brief is defective" and further states that "Form paragraphs 12.08-12.13, 12.16, 12.17, and 12.69-12.78, or Form PTOL-462, 'Notification of Non-Compliance with 37 CFR 1.192(c),' may be used concerning the appeal

brief." The Examiner has used neither the guidance of Office-approved form paragraphs nor form PTOL-462. The Manual of Patent Examining Procedure (MPEP) does not provide for any other exceptions. That is, the MPEP does not provide any basis for the requirements in the Notification. The Examiner, at best, has used a modified version of sole concluding form paragraph 12.78 in the "Conclusion" section of the Notification.

The Notification's lack of Office-approved form paragraphs or form PTOL-462 is taken as further evidence that the Examiner's actions do not comply with the approved patent examining procedures of the Office. Thus, the Notification does not meet the procedural rules of the Office. Hence, it is further submitted that the holding of defective appeal brief should be withdrawn on this basis.

Furthermore, since the Notification is not in compliance with the Office's own rules and procedures, the Notification is defective.

Unless the Examiner can produce some legal authority with respect to limiting brief size, then it appears that the Examiner has clearly exceeded his bounds of authority. Not only did the Examiner attempt to create his own new rules, but he further attempted to judge Appellants' Brief based on these self-created new rules. Nevertheless, Appellants have shown the Examiner's actions to be in clear error.

The Notification also violates Appellants' Constitutional rights. There is no limit on the number of claims which can be filed. Also, there is no limit on the number of different rejections that can be applied by the Office. Limiting the size of Appellants' Brief would prevent Appellants from being able to fully respond to all rejections in an (unlimited in size) Office Action. This would constitute a denial of Due Process.


Additionally, unless the Office is holding all appeal briefs to a specific (lower) size limit (which it is not), then the Office's action against Appellants constitutes action which is arbitrary and capricious, and a violation of Appellants Due Process and Equal Protection rights.

The holding of defective appeal brief should be withdrawn for the reasons presented herein. Furthermore, the holding of defective appeal brief should be withdrawn on the basis that (1) the Brief is already in full compliance with 37 C.F.R. § 1.192(c), and (2) the Notification is defective by not being in compliance with the Office's own rules and procedures. Appellants respectfully request that their petition be granted.

Appellants note that the Notification does not mention any other defective brief issues. Hence, Appellants conclude that the Examiner did not find any other defective brief issues during his complete review of Appellants' entire Brief in accordance with his examining duties. Therefore, Appellants also respectfully request that the Examiner be instructed to write an Examiner's Answer so that this application may properly proceed without further delay on its way to the Board.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,


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US Code as of: 01/23/00

Sec. 559. Effect on other laws; effect of subsequent statute

This subchapter, chapter 7, and sections 1305, 3105, 3344, 4301(2)(E), 5372, and 7521 of this title, and the provisions of section 5335(a)(B) of this title that relate to administrative law judges, do not limit or repeal additional requirements imposed by statute or otherwise recognized by law. Except as otherwise required by law, requirements or privileges relating to evidence or procedure apply equally to agencies and persons. Each agency is granted the authority necessary to comply with the requirements of this subchapter through the issuance of rules or otherwise. Subsequent statute may not be held to supersede or modify this subchapter, chapter 7, sections 1305, 3105, 3344, 4301(2)(E), 5372, or 7521 of this title, or the provisions of section 5335(a)(B) of this title that relate to administrative law judges, except to the extent that it does so expressly.